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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,720	05/09/2001	James Thomas Shiveley	0188.0009	3645

7590 12/19/2005

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 09/851,720	Applicant(s) SHIVELEY, JAMES THOMAS	
	Examiner Stephen Gravini	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 22-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2 and 6-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 3-5 and 22-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20010808</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Claims 3-5 and 22-34 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 25, 2005. Since multiple sets of claims appear in the application, it is not clear which set of claims the applicant requests for examination. Based on the restriction requirement and the published application, examination will follow on the published application claims.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. In this application, the residence is stated but the post office address, or mailing address, is blank. It is not clear whether the declared residence is the same as the declared mailing address. See 37 CFR 1.63(c) and 37 CFR 1.76.

The declaration is considered defective because it declares that the present application is a continuation in part, but does not refer which application it continues or what is considered the new matter such that it is in part with a parent application. Appropriate correction is required.

Claim Objections

Claim 1 is objected to because it is not a complete sentence, which is required under current Office practice. In this application, two sets of claims exist. Since applicant has not clearly set forth which claims are to be examined, the Office assumes that the published claims in pre-grant publication US 2002/0034594 are the intended claims for examination because in the three and one half years of the publication, no papers have been filed to clarify which claims are to be examined. It is requested that in response to this action, the claims which are to be finally examined are clearly set forth.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Those claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 as published, contains only a preamble. A preamble, by itself without any body of a claims, is not considered enabling because the sentence is construed to be comprising nothing. Claim 2 recites an infrared heating source in the preamble but an UV heating source in the body of the claim. Under current Office practice infrared and UV heating sources are patentably distinct as one is classified in class 34 subclass 266

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(infrared) while the other is classified in class 34 subclass 275 (UV). Claim 2 is considered non enabling because preamble infrared heating system is not patentably consistent with body claimed UV source.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 6-21, all of the claims contain subject matter that lack proper antecedent basis. In claim 12, the first and second source lacks a positive antecedent basis since the claims it depends upon do not recite a first of a plurality of sources.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by either Wyatt (US 5,749,986) or applicant submitted information disclosure statement non patent literature reference.

Claims 2 and 6-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated applicant submitted information disclosure statement non patent literature reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolinski et al. (US 2,876,187) in view of Dulay (US 5,117,562). Wolinski is considered to clearly anticipate the claimed invention, except for the claimed programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature. Dulay, another heating source, is considered to disclose a programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature at column 3 line 11 through column 5 line 55. It would have been obvious to one skilled in

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the art to combine the teachings of Wolinski with the programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature, considered disclosed in Dulay, for the purpose of regulated coating treatments based on controlled sensed temperatures.

Claims 6-8 and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt in view of Dulay. Wyatt is considered to clearly anticipate the claimed invention as rejected above, except for the claimed second heating sources with associated power levels and recording/ controller parameters. Dulay, another heating source, is considered to disclose plural heating sources and recording/ controller parameters at column 3 line 11 through column 5 line 55. It would have been obvious to one skilled in the art to combine the teachings of Wyatt with plural heating sources and recording/ controller parameters, considered disclosed in Dulay, for the purpose of regulated coating treatments based on controlled sensed temperatures. Furthermore, Wyatt in view of Dulay is considered to disclose the claimed invention except for the claimed associated power levels. It would have been an obvious matter of design choice to provide a specific associated power levels, since the prior art performs the claimed associated power levels in substantially the same way using substantially the same means for substantially the same function with substantially the same result.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wyatt in view of Dulay in further view of Turnbull et al. (US 3,851,402). Wyatt in view of Dulay is

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considered to clearly anticipate the claimed invention as rejected above, except for the claimed heat source separate zoning. Turnbull, another heating source, is considered to disclose heat source separate zoning at column 5 line 28 through column 8 line 24. It would have been obvious to one skilled in the art to combine the teachings of Wyatt in view of Dulay with heat source separate zoning, considered disclosed in Turnbull, for the purpose of regulated coating treatments based on various zones of article treatment.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 6-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,520,097 in view of in view of Dulay. Applicant's earlier patent is considered to claim the same

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subject matter as the present claimed invention, except for the claimed programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature.

Dulay, another heating source, is considered to disclose a programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature at column 3 line 11 through column 5 line 55. It would have been obvious to one skilled in the art to combine the teachings of applicant's earlier patent with the programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature, considered disclosed in Dulay, for the purpose of regulated coating treatments based on controlled sensed temperatures.

Claims 1-2 and 6-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-20 of U.S. Patent Reissue Application No. 11/062,352 in view of in view of Dulay. Applicant's application is considered to claim the same subject matter as the present claimed invention, except for the claimed programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for

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detection of the article temperature. Dulay, another heating source, is considered to disclose a programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature at column 3 line 11 through column 5 line 55. It would have been obvious to one skilled in the art to combine the teachings of applicant's application with the programmable recording/controller for first analyzing the treatment of coating on the coated articles and subsequently controlling treatment of the coated articles in accordance with the previous analysis, and a temperature monitor for detection of the article temperature, considered disclosed in Dulay, for the purpose of regulated coating treatments based on controlled sensed temperatures. This is a provisional obviousness-type double patenting rejection.

Conclusion

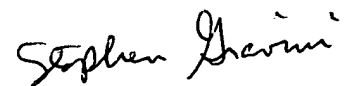
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 571 272 4875. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMG
December 14, 2005

A handwritten signature in cursive script, reading "Stephen Gervini".